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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,885	01/09/2001	Muhammad Chishti	18563-002300	6714

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EXAMINER

NAJARIAN, LENA

ART UNIT PAPER NUMBER

3626

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/756,885

Applicant(s)

CHISHTI ET AL.

Examiner

Lena Najarian

Art Unit

3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: NONE.
Claim(s) rejected: 1-30 and 46-59.
Claim(s) withdrawn from consideration: NONE.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

Continuation of 11.

Applicant's arguments filed 6/5/06 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 6/5/06.

(1) Applicant argues at page 9 that the Examiner has made a new ground of rejection, which was not necessitated by a previous amendment by the Applicant and Applicant has not previously been afforded an opportunity to address this new rejection. In particular, the Examiner has, for the first time, rejected claims 1-5 and 12-13 as allegedly being obvious in view of the specific combination of references of DeBruin-Ashton and Falchuk, in further view of Tawil. While claims 1 and 14 were amended in Applicant's response mailed 9/8/2005, the amendments consisted of merely clarifying, in response to the Examiner's rejection of the claims under 35 U.S.C. 101.

As per this argument, the Examiner respectfully disagrees that the final rejection is premature. Applicant did more than merely clarify in response to the 101 rejection. It was not until the amendment filed 9/12/05 that Applicant added the limitation of "accessing an electronic database having information comprising a number of procedures performed...." to claim 1. To address these newly added limitations, a new ground of rejection was presented in the final rejection mailed 3/3/06 that was clearly necessitated by Applicant's amendment of the claims.

(2) Applicant argues at page 10 that the Examiner has cited no real suggestion or motivation to combine the cited references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner respectfully submits that a motivation was provided for each and every combination.

(3) Applicant argues at page 10 that Falchuk fails to teach certifying a group of practitioners to perform a medical procedure.

This argument was addressed in the final rejection mailed 3/3/06 (see page 10 of Final Rejection), and incorporated herein.

(4) Applicant argues at page 11 that Tawil does not teach "providing to the identified individual patients a list of certified practitioners, selected from the electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list." Thus, Tawil does not provide the teachings that are missing from DeBruin-Ashton and Falchuk.

As per this argument, the Examiner did not only rely on Tawil for the features listed above. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(5) Applicant argues at page 12 that Kurzius is directed to employment candidate recruiting and has nothing to do with referring patients to medical practitioners.

This argument was addressed in the final rejection mailed 3/3/06 (see pages 10-11 of Final Rejection), and incorporated herein.

(6) Applicant argues at page 13 that Joao does not teach certifying dental practitioners to perform a dental procedure.

This argument was addressed in the final rejection mailed 3/3/06 (see page 11 of Final Rejection), and incorporated herein.